

REMARKS

Claims 1-4, 9-34, 36 and 37 are now pending in the application, with claims 1, 21 and 30 being the independent claims. Reconsideration and further examination are respectfully requested.

Initially, objection was made to claim 24 for failing to further limit the subject matter of previous claim 12. In response, Applicant has amended claim 24 so that it now depends from independent claim 30. Accordingly, withdrawal of this objection is respectfully requested.

In the Office Action, claims 1-5, 7-8, 11-32, 34 and 36 were rejected under 35 U.S.C. § 103(a) over JPH3-170101 (Kubota) in view of U.S. Patent No. 4,658,514 (Shin); claims 9-10 and 33 were rejected under § 103(a) over Kubota in view of Shin and U.S. Patent No. 2,114,300 (Gustin); claims 1-5, 7-34 and 36 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-20 of copending Application No. 11/530,419 in view of Shin (the ‘419 application); and claims 1-5, 7-34 and 36 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-19 of U.S. Patent No. 7,191,549 (the ‘549 patent) in view of Shin. Withdrawal of these rejections is respectfully requested for the following reasons.

Prior-Art Rejections

Independent claim 1 is directed to a shoe that includes: (a) a bottom surface that is adjacent to the ground in normal use and that has a plurality of indentations, with lower extending portions between the indentations; (b) a sole that forms at least a portion of the bottom surface; (c) an upper portion extending above the sole; and (d) a plurality of small particles, comprising at least one of wood and paper, bonded to at least some of the lower extending

portions, but with each of the plurality of indentations being predominantly uncoated with such small particles.

The foregoing combination of features is not disclosed or suggested by the applied art. For instance, no permissible combination of the applied art would have disclosed or suggested at least the feature of a bottom surface of a shoe that includes indentations separated by lower extending portions, in which small particles, comprising at least one of wood and paper, are bonded to at least some of the lower extending portions, but where the indentations are predominantly uncoated.

In discussing claims 9 and 10, which together encompass this limitation, the Office Action appears to acknowledge that no permissible combination of Kubota and Shin would have disclosed or suggested such a feature. However, the Office Action also asserts:

Gustin et al. discloses that it is old and conventional to use wood fiber and paper dust as materials for making shoe soles. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use wood or paper as part of the natural fibers used for the small particles of JPH3-170101 as taught by Gustin et al. since wood or paper are considered as natural fibers.

In response, it is first noted that Gustin concerns, "...production of a composition which may be used for cold molding and which has a wide application to many lines of industry." See, e.g., the very first paragraph of Gustin. At page 1 column 2 lines 28-41, Gustin then notes that wood fiber or flour or paper dust can be used as *filler material* in the molding composition. At the same time, there is absolutely nothing in Gustin that suggests bonding small particles to any portion of the bottom surface of a shoe, much less as presently recited.

In short, any modification of Kubota's shoe based on the teachings of Gustin would only have involved the introduction of certain filler materials into the molding compositions that Kubota uses. One of ordinary skill in the art would not have been motivated to modify the

specific kinds of particles that are flocked on by Kubota based on anything that is disclosed in or suggested by Gustin.

Accordingly, independent claim 1 would not have been obvious in view of any permissible combination of Kubota, Shin and Gustin.

Independent claim 30 is directed to a shoe that includes: (a) a bottom surface that is adjacent to the ground in normal use and that has a plurality of indentations, with ground-contacting portions between the indentations; (b) a sole that forms at least a portion of the bottom surface; (c) an upper portion extending above the sole; and (d) a plurality of small particles, comprising at least one of wood and paper, bonded differentially to different areas of the bottom surface, with each of a plurality of the ground-contacting portions being coated more than each of the plurality of indentations.

The foregoing combination of features is not disclosed or suggested by the applied art. For instance, no permissible combination of the applied art would have disclosed or suggested at least the feature of a shoe bottom-surface configuration having a plurality of indentations with ground-contacting portions between the indentations, in which small particles, comprising at least one of wood and paper, are bonded differentially to different areas, with each of a plurality of ground-contacting portions being coated more than each of the plurality of indentations.

This feature is similar to the limitation of independent claim 1 discussed above. For the same reasons set forth above, such a feature would not have been obvious in view of any permissible combination of Kubota, Shin and Gustin.

Accordingly, independent claim 30 also is believed to be allowable over the applied art.

Independent claim 21 is directed to a shoe that includes: (a) a bottom surface that is adjacent to the ground in normal use and that has a plurality of indentations, with lower

extending portions between the indentations; (b) a sole that forms at least a portion of the bottom surface; (c) an upper portion extending above the sole; and (d) a plurality of small particles bonded to at least some of the lower extending portions, but with each of the plurality of indentations being predominantly uncoated with such small particles, where the small particles are bonded using a temporary adhesive that allows the particles to wear off during normal outdoor use.

The foregoing combination of features is not disclosed or suggested by the applied art. For instance, nothing in the applied art discloses or suggests bonding a plurality of small particles to at least some of the lower extending portions of the bottom surface of a shoe using a temporary adhesive that allows the particles to wear off during normal outdoor use, but with each of a plurality of indentations on the bottom surface of the shoe being predominantly uncoated with such small particles.

With respect to this feature, the Office Action first asserts that any of the adhesives disclosed in Kubota can be construed as a temporary adhesive “since they are prone to reduction in adhesive strength over time due to temperature, pressure or contact with fluids or rough surfaces.” However, even if it is true that any of Kubota’s listed adhesives loses its adhesive strength over time (and there is nothing in Kubota to indicate that this is in fact the case), that still would not mean that the subject adhesive is a “temporary adhesive”, as that term would be understood by one of ordinary skill in the art. Rather, as disclosed in the references that are being submitted with the accompanying Information Disclosure Statement, the term “temporary adhesive” is well-understood to mean an adhesive that is not capable of withstanding significant amounts of strain or force and that is suitable for only short-term use. Nothing in Kubota indicates that any of its described adhesives is only suitable for temporary adhesion.

The Office Action next asserts that the “temporary adhesive” recited in claim 21 “has no reference point” and therefore reads on the adhesives, such as rubber-group adhesives and aqueous group type adhesives, listed in Kubota, because “the particles of [Kubota] will eventually wear off.” In response, as noted above, the term “temporary adhesive” has a well-understood meaning in the art. Merely because an adhesive eventually will wear off (as everything naturally will) does not make it a “temporary adhesive” as that term is ordinarily understood in the art. There simply is nothing in Kubota that indicates that any of its adhesives is a temporary adhesive or that it would be desirable to use a temporary adhesive in connection with its flocking operations.

For these reasons, independent claim 21 is believed to be clearly allowable over the applied art.

Dependent claims 22 and 23 recite that the temporary adhesive (recited in independent claim 21) allows the particles to wear off within specific periods of time (3 days and 3 weeks, respectively) when worn outdoors in an urban environment on a full-time basis. With respect to these features, the Office Action asserts,

. . . it would depend on the amount of time desired for the particles to remain on the shoe, and would have been obvious to one of ordinary skill in the art to select the adhesiveness of the adhesive to be used to cover a certain time- wear parameter, since the amount of time, “days” or “weeks” are result determined parameters and such would have been well within the expedient and obvious to the ordinary skilled artisan.

However, the flaw with this reasoning is that Kubota does not disclose or even remotely suggest any concept of trying to limit the amount of time that the flocked-on fibers or particles are to remain on the shoe. Even the Office Action has not pointed to anything in Kubota indicating that this is one of Kubota’s goals. Rather, in light of Kubota’s intended purpose of

providing a non-slip surface, it must be assumed that Kubota wanted its flocked-on fibers or particles to remain on the shoe as long as possible. Accordingly, there would have been no motivation whatsoever to attempt to limit the duration of adherence to any extent at all, much less as presently recited.

For these additional reasons, claims 22 and 23 are believed to be allowable over the applied art.

Nonstatutory Obviousness-Type Double-Patenting Rejections

With respect to the provisional obviousness-type double-patenting rejection, Applicant notes that the specific language of the claims in the present application, as well as the specific language of the claims in the ‘419 application, potentially is still subject to change. Accordingly, the following remarks only address the broad general differences between the present claims and the claims in the ‘419 application.

First, Applicant notes that present independent claims 1 and 30, as amended above, recite that the small particles comprise at least one of wood and paper. In contrast, the claims of the ‘419 application recite the use of individual natural fibers. Shin does not say anything at all about wood, paper or, for that matter, individual natural fibers.

Second, the placement of the particles according to the present claims is largely the opposite of the placement of the individual natural fibers of the ‘419 application. Moreover, Shin does not appear to say anything whatsoever about placement of any kind of particles or individual natural fibers. Accordingly, one of ordinary skill in the art would not have modified the claims of the ‘419 application based on Shin in any manner that would have resulted in the present claims.

Third, even the Office Action does not assert that either the claims of the ‘419 application or Shin says anything at all about the temporary adhesive recited in independent claim 21.

For these reasons, the present claims could not possibly have been obvious variations of the claims of the ‘419 application, even when read in conjunction with Shin’s disclosure. Accordingly, withdrawal of the provisional obviousness-type double-patenting rejection is respectfully requested.

With respect to the nonprovisional obviousness-type double-patenting rejection, as noted above, independent claims 1 and 30 have been amended to recite that the small particles comprise at least one of wood and paper. Neither the claims of the ‘549 patent nor Shin, whether alone or in combination, discloses or suggests anything at all about this feature of the present invention. In addition, even the Office Action does not assert that this combination says anything at all about the temporary adhesive recited in independent claim 21. Accordingly, based on the differences between the present claims and the claims of the ‘549 patent (even in view of Chin), withdrawal of this rejection is respectfully requested.

New claim 37

New claim 37 depends from independent claim 21 (discussed above) and recites the additional feature that the temporary adhesive allows the particles to wear off within no more than 3 months when worn outdoors in an urban environment on a full-time basis. This feature of the invention is similar to the features recited in currently pending dependent claims 22 and 23 (also discussed above) and is supported, e.g., by page 5 lines 5-11 of the Specification and, particularly in combination with the other features recited in claim 1, is not believed to be disclosed or suggested by the applied art.

Additional Comments

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits, in light of the remarks set forth above, is respectfully requested.

In order to sufficiently distinguish Applicant's invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicant's invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicant's invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 502490. If an extension of time under 37 C.F.R. 1.136 is required for the filing of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account.

Dated: September 8, 2010

Respectfully submitted,

JOSEPH G. SWAN, P.C.

JOSEPH G. SWAN,
A PROFESSIONAL CORPORATION
1334 Parkview Avenue , Suite 100
Manhattan Beach, California 90266
Telephone: (310) 372-8624
Facsimile: (310) 356-3845

By _____ /Joseph G. Swan/ _____
Joseph G. Swan
Registration No. 41,338